

23. (previously presented) A compound according to claim 22 wherein
- $R^1$  is trifluoromethyl,
- $R^2$  is hydrogen, and
- $R^3$  is a pyrimidine.
24. (previously presented) A compound according to claim 22 wherein  $R^1$  and  $R^2$  are each chloro, and  $R^3$  is a pyrimidine.
25. (previously presented) A compound according to claim 1 which has an  $IC_{50}$  of less than 20  $\mu M$  when tested in one or both of
- (i) an ICAM-1/LFA-1 Biochemical Interaction Assay, or
- (ii) an ICAM-1/JY-8 Cell Adhesion Assay
26. (previously presented) A method for ameliorating a pathology in a mammal arising from the interaction of LFA-1 with ICAM-1 or ICAM-3 comprising administering to said mammal a therapeutic amount of a compound according to claim 1.
27. (previously presented) A method according to claim 26 wherein the pathology is selected from an inflammatory disease, an autoimmune disease, tumor metastasis, allograft rejection and reperfusion injury.

## **REMARKS**

### **I. Status of the Claims**

Claims 1-27 are pending in the application. Claims 1, 17, 19, and 20 have been amended. Claim 15 is withdrawn from consideration.

Claim 1 has been amended to require that  $R^1$  and  $R^3$  be selected from the recited group. In light of this amendment to claim 1, dependent claims 17, 19, and 20 have

been amended to expand the recited group for R<sup>1</sup> to include the compound of formula II. These amendments are also consistent with the existing provisos in claims 17, 19, and 20 that R<sup>1</sup> be a pyrimidine if R<sup>3</sup> does not define a pyrimidine.

Claim 1 has also been amended to define heterocyclyl as chosen from 3-, 4-, 5-, 6- and 7-membered rings to render this definition consistent with the definition of unsubstituted and substituted heterocyclyl for R<sup>10</sup> and R<sup>11</sup>. Other minor amendments have been made for the purposes of clarity.

No new matter has been added by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Accordingly, Applicants respectfully request further examination of the claims.

The Examiner recommends that claim 15 be deleted, asserting that it is drawn to a non-elected invention. *Final Office Action* at p. 2. Applicants respectfully disagree. Dependent claim 15 can define a non-pyrimidine so long as the compound of formula I includes a pyrimidine at the R<sup>1</sup> or R<sup>3</sup> position, a proviso that is explicitly recited in independent claim 1. Accordingly, Applicants respectfully request examination of claim 15.

## II. Objection to the claims

The Examiner has objected to claim 13 as allegedly "drawn to multiple inventions for reasons set forth in the restriction requirement." *Final Office Action* at p. 2. The Examiner further states that "only one of R<sup>1</sup> or R<sup>3</sup> is permitted to be a pyrimidine ring." *Id.* at 3.

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Applicants respectfully disagree. Both R<sup>1</sup> or R<sup>3</sup> can be a pyrimidine so long as at least one of R<sup>1</sup> or R<sup>3</sup> defines a group of formula II, which can be a pyrimidine. Stated otherwise, R<sup>1</sup> and/or R<sup>3</sup> can be both a group of formula II and a pyrimidine. Claim 13 further limits the group of formula II such that D, B, Y, and Z are chosen from specified radicals. Claim 13 can read on the elected invention whether or not the group of formula II defines a pyrimidine. For example, if claim 13 defines a group of formula II that is not a pyrimidine and this group is assigned as R<sup>3</sup>, then R<sup>1</sup> is necessarily a pyrimidine (and vice versa). Thus, claim 13 does not have to define a pyrimidine to read on the elected invention by virtue of the proviso in claim 1 requiring that at least one of R<sup>1</sup> or R<sup>3</sup> be a pyrimidine.

Finally, Applicants respectfully disagree that "only one of R<sup>1</sup> or R<sup>3</sup> is a pyrimidine as was done in claim 20." *Id.* In claim 20, the R<sup>3</sup> is selected from four substituents. The third substituent is a pyrimidine. Thus, if R<sup>3</sup> is not a pyrimidine, the proviso of claim 20 requires that R<sup>1</sup> be a pyrimidine. If R<sup>3</sup> is a pyrimidine, the proviso does not exclude R<sup>1</sup> from being a pyrimidine. Moreover, claim 20 has been amended to clarify this existing proviso to allow R<sup>1</sup> to be selected from the group of formula II, which can define a pyrimidine.

Accordingly, it is respectfully requested that the objection to claim 13 be withdrawn.

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**III. Rejection under 35 U.S.C. § 112, second paragraph**

Claims 1-14 and 16-27 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. *Final Office Action* at pp. 3-4. Applicants respectfully traverse this rejection.

The Examiner believes that the proviso "one or more than one of R<sup>1</sup> or R<sup>3</sup> is a group of formula II as defined above" is not clear. *Id.* at p. 3. The Examiner questions how "more than one of R<sup>1</sup> or R<sup>3</sup> is a group of formula II, when applicants indicate that at least one of R<sup>1</sup> or R<sup>3</sup> is a pyrimidine." *Id.*

Definiteness under 35 U.S.C. § 112, second paragraph is determined from the point of view of one of ordinary skill in the art. M.P.E.P. § 2173.02. ("[T]he examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope."). Applicants respectfully submit that one of ordinary skill in the art would appreciate that radicals encompassed by formula II are not mutually exclusive from pyrimidines. As stated above, R<sup>1</sup> and/or R<sup>3</sup> can be both a group of formula II and a pyrimidine. Applicants provide some examples of compounds that fall within the elected invention:

Example 1. R<sup>1</sup> is a pyrimidine of any formula and R<sup>3</sup> is a non-pyrimidine of formula II. (see, e.g., proviso of claim 2). Here, only one of R<sup>1</sup> and R<sup>3</sup> is a pyrimidine and only one of R<sup>1</sup> and R<sup>3</sup> is a group of formula II.

Example 2. R<sup>1</sup> is a pyrimidine but not of formula II and R<sup>3</sup> is a pyrimidine of formula II. Here, both of R<sup>1</sup> and R<sup>3</sup> are pyrimidines and only one of R<sup>1</sup> and R<sup>3</sup> is a group of formula II.

Example 3. R<sup>1</sup> is a pyrimidine of formula II and R<sup>3</sup> is a pyrimidine of formula II. Here, both of R<sup>1</sup> and R<sup>3</sup> are pyrimidines and both of R<sup>1</sup> and R<sup>3</sup> are groups of formula II.

The claimed invention does not cover the scenarios where neither R<sup>1</sup> and R<sup>3</sup> is a pyrimidine or neither R<sup>1</sup> and R<sup>3</sup> is a group of formula II.

Applicants respectfully submit that the claim as presented in the previous response to the office action is sufficiently clear. Nevertheless, claim 1 has been amended in accordance with the Examiner's second suggested amendment at p. 4. Claim 1, as amended, defines R<sup>1</sup> and R<sup>3</sup> as being chosen from the same list of substituents as for R<sup>2</sup>, R<sup>4</sup>, and R<sup>5</sup>. The provisos remain unamended.

Accordingly, Applicants respectfully request withdrawal of this rejection.

**IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (617) 452-1621.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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